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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

*13*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/266,935

Applicant(s)

Li et al.

Examiner

Jezia Riley

Group Art Unit

1656



X Responsive to communication(s) filed on Jun 26, 2000

X This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

X Claim(s) 30-54 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

X Claim(s) 30-45 is/are allowed.

X Claim(s) 46-54 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No(s). 11, 12

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The art unit for this application has changed. Applicant is informed, that any future response should be directed to Art Unit 1656.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 46-54 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Claim 46 is vague and indefinite because it is unclear, of what are the metes and bounds of the terms "derivatives thereof". The definition on pages 24-25 is for derivatives of the formulae I and II. No definition described the derivatives of the compounds of instant claim 46.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 46-54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mullis et al. (4,800,159).

Mullis et al. disclose a method for amplifying any target nucleic acid and a kit. (See abstract and col. 2-5, for example).

6. Claims 46-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lee (Patent # 5,187,935).

Lee discloses the basic steps of the chain-termination approach to DNA sequencing where the fluorescently labeled chain-terminating nucleotides can be 2',3', dideoxy-7-deazainosine triphosphate (col. 3-5).

Applicants' argument are that the references do not disclose the compounds comprising group consisting of one or more amino acids, etc. This is not convincing because the phrase derivatives thereof are unclear as discussed in 112 2nd rejection above and therefore the rejections are maintained.

8. Claims 30-45 are allowed.

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

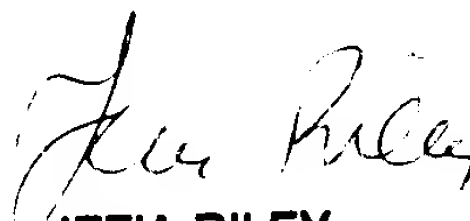
A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed

until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is (703) 305-6855. The Examiner may normally be reached Monday through Friday, 0900 - 1700 EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Gary Jones, may be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Receptionist whose telephone number is (703) 308-0196.

Any necessary fax can be sent to (703) 308-4242.

  
**JEZIA RILEY**  
**PRIMARY EXAMINER**